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09/324,601	06/02/1999	STEVEN C. ROBERTSON	ROBERT.P001	1766
7590 PATRICK M. DWYER PC 14419 GREENWOOD AVE N, BOX 322 SEATTLE, WA 98133			EXAMINER FADOK, MARK A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 The opinion in support of the decision being entered today is *not* binding precedent
2 of the Board.

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4 UNITED STATES PATENT AND TRADEMARK OFFICE

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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

9

10

11 *Ex parte* STEVEN C. ROBERTSON

12

13

14 Appeal 2007-1813
15 Application 09/324,601
16 Technology Center 3600

17

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19 Decided: August 20, 2007

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22 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
23 DAVID B. WALKER, *Administrative Patent Judges*.

24

25 FETTING, *Administrative Patent Judge*.

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27

28 DECISION ON APPEAL

29

30

STATEMENT OF CASE

31 Steven C. Robertson (Appellant) seeks review under 35 U.S.C. § 134 of a Non-
32 Final rejection of claims 23-37, the only claims pending in the application on
33 appeal.

34 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6.

35

36 We AFFIRM.

2 The Appellant invented an online gift certificate and contribution broker that
3 allows consumers to purchase gift certificates that may be redeemed at any
4 participating electronic merchant (Specification 1:Background – Field of
5 Invention).

6 An understanding of the invention can be derived from a reading of exemplary
7 claim 23, which is reproduced below [bracketed matter and some paragraphing
8 added].

9 23. A system for providing an electronic gift certificate service for
10 users over a distributed network, comprising:

11 [1] a plurality of merchant sites connected to the distributed network,
12 each merchant site running at least one application to provide
13 an online service to users over the distributed network;

14 [2] a plurality of user computers connected to the distributed network,
15 each user computer running at least one application to access
16 the online service at a merchant site;

17 [3] a gift certificate authority site connected to the plurality of
18 merchant sites, the gift certificate site including

19 [a] a user database and
20 [b] a merchant database,

21 each database containing authentication information as to
22 respective users and merchants,

23 [c] and a gift certificate database
24 which stores

25 gift certificate data and
26 transaction data

27 related to particular gift certificates,

1 [d] the users accessing the merchant sites from the user
2 computers over the distributed network; and
3 [e] an authentication protocol for allowing the gift certificate
4 site to authenticate users and merchants;

5 [4] whereby

6 [a] a user purchases a gift certificate having a unique gift
7 certificate identification code on the gift certificate authority
8 site for use at a merchant site, and
9 [b] a merchant site processes the gift certificate through the gift
10 certificate database on the gift certificate authority site.

11 This appeal arises from the Examiner's Non-Final Rejection, mailed May 9,
122006. The Appellant filed an Appeal Brief in support of the appeal on August 28,
132006, and an Examiner's Answer to the Appeal Brief was mailed on October 5,
142006. A Reply Brief was filed on December 11, 2006.

15 PRIOR ART

16 The Examiner relies upon the following prior art:

17Gillin US 7,010,512 B1 Mar. 7, 2006

18 REJECTION¹

19 Claims 23-37 stand rejected under 35 U.S.C. § 102(e) as anticipated by Gillin.

6¹ An August 13, 2004 Final Rejection contained three rejections under 35 U.S.C.
7§ 103. The Brief contends these rejections (Appeal Br. 6-16). The Examiner
8withdrew these rejections and introduced a single new ground of rejection under
935 U.S.C. § 102(e) (Non-Final Rejection 2-4; Answer 2-3). Thus, the rejections
10under 35 U.S.C. § 103 are not before us, and the Appellant's contentions are
11therefore moot.

1 ISSUES

2 Thus, the issue pertinent to this appeal is whether the Appellant has sustained
3 its burden of showing that the Examiner erred in rejecting claims 23-37 under
4 35 U.S.C. § 102(e) as anticipated by Gillin.

5 The pertinent issue turns on whether Gillin describes a gift certificate site
6containing merchant, user, and gift certificate databases with authentication
7information for merchants and users.

8

FACTS PERTINENT TO THE ISSUES

10 The following enumerated Findings of Fact (FF) are believed to be supported
11 by a preponderance of the evidence.

12 *Claim Construction*

1 *Gillin*

- 2 4. Gillin is directed towards debit/credit/charge accounts, but without
3 issuing physical cards and providing them to the gift recipient, which
4 provides significant advantages to transactions normally involving gift
5 certificates (Gillin, col. 4, ll. 55-59).
- 6 5. Gillin’s “transfer instrument” is used to refer generically to the result of
7 Gillin’s inventive transfer methods, which will typically be used in the
8 gift giving context. The transfer instrument is intangible in that it is not
9 physically produced (Gillin, col. 8, ll. 39-43).
- 10 6. Gillin describes use of its transfer instrument for the purchase of goods
11 or services from any merchant who is capable of processing economic
12 transactions involving one of the plurality national card accounts for
13 which a physical card has issued, but without presentment of the
14 physical card (Gillin, col. 5, ll. 13-19).
- 15 7. Gillin uses the existing authorization infrastructure of Visa, Mastercard,
16 and American Express (Gillin, col. 7, ll. 30-33).
- 17 8. Gillin shows communication among the user, merchant and the transfer
18 instrument account (Gillin, Fig. 3).
- 19 9. In Gillin, the transfer instrument issuer’s Issuing Bank enters the
20 instrument recipient’s account information into its database (Gillin, col.
21 7, ll. 62-67).
- 22 10. In Gillin, merchants who wish to accept payments using the cards
23 register with a bank affiliated with the card association. Banks which
24 register merchants are often referred to as acquiring banks or acquirers.

1 Of course, in many instances, the same bank may be both an issuing
2 bank and an acquiring bank. American Express and Discover operate in
3 the roles of both the issuing and acquiring banks (Gillin, col. 9, ll. 5-14).

4 11.In Gillin, authorization typically involves an authorization center which
5 is operated either by or on behalf of the acquiring bank. In general the
6 merchant contacts the authorization center which may in some instances
7 contact the card issuing bank to verify availability of funds or, if the
8 transaction amount is small enough, merely verify that the card has not
9 been blacklisted (Gillin, col. 9, ll. 26-32).

10 12.In Gillin, according to one embodiment, the offerer obtains payment
11 card accounts from an issuing bank. Those accounts, and their
12 associated information, are recorded in the database. The database
13 contains fields for the buyer, the recipient, the denomination, messages
14 to buyers or recipients, a multi-character unique identifier, and a product
15 family table (Gillin, col. 14, l. 47 – col. 15, l. 32).

16 13.In Gillin, payment methods may follow the more prevalent internet
17 related payment schemes, such as CyberCash. CyberCash itself requires
18 merchant registration with CyberCash (Gillin, col. 10, ll. 19-49).

19 14.Gillin allows restrictions on the time frame and the amount of the
20 instrument (Gillin, col. 23, ll. 44-47).

21 15.Gillin describes the purchaser may have been allowed to request
22 notification of when the transfer instrument was used and an identifier
23 for the merchant with whom it was used (Gillin, col. 21, ll.18-23).

16.Gillis states that an additional feature of the transfer instrument is the
ability to make the purchaser anonymous to the recipient (Gillin. col. 20,
ll. 24-31).

4 17. Gillis states that the purchaser provides the recipient's e-mail address,
5 telephone number, and/or mailing address (Gillin, col. 17, ll. 40-43).

6

PRINCIPLES OF LAW

8 Claim Construction

9 During examination of a patent application, pending claims are given
10 their broadest reasonable construction consistent with the specification. *In*
11 *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969);
12 *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827,
13 1834 (Fed. Cir. 2004).

14 Although a patent applicant is entitled to be his or her own lexicographer of
15patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
16347 F.2d 578, 580, 146 USPQ 69, 70 (CCPA 1965). The applicant must do so by
17placing such definitions in the Specification with sufficient clarity to provide a
18person of ordinary skill in the art with clear and precise notice of the meaning that
19is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ 2d 1671,
201674 (Fed. Cir. 1994) (although an inventor is free to define the specific terms
21used to describe the invention, this must be done with reasonable clarity,
22deliberateness, and precision; where an inventor chooses to give terms uncommon
23meanings, the inventor must set out any uncommon definition in some manner
24within the patent disclosure so as to give one of ordinary skill in the art notice of
25the change).

1*Anticipation*

2 "A claim is anticipated only if each and every element as set forth in the claim
3is found, either expressly or inherently described, in a single prior art reference."
4*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d
51051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or
6compositions, either generically or as alternatives, the claim is deemed anticipated
7if any of the structures or compositions within the scope of the claim is known in
8the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed.
9Cir. 2001). "The identical invention must be shown in as complete detail as is
10contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236,
119 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as
12required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of
13terminology is not required. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566,
141567 (Fed. Cir. 1990).

15 ANALYSIS

16 *Claims 23-37 rejected under 35 U.S.C. § 102(e) as anticipated by Gillin.*

17 *Independent Claim 23*

18 The Examiner found that Gillin describes all of the elements of claim 23
19(Answer 4:¶ beginning "In regards to claim 23").

20 The Appellant presents a long list of contentions regarding claim 23 that we
21next analyze. But since it is apparent that the most pertinent issue is whether Gillin
22describes a gift certificate site containing merchant, user, and gift certificate
23databases with authentication information for merchants and users, we address this
24first.

1 Gillin relies on the banks who issue credit cards to execute its operations.
2Gillin expressly states that in many instances, the same bank serves both merchant
3and user (FF). Thus, the databases that contain the records for those merchants
4and users would be on the same site. Gillin also states that the transfer
5instruments, which are the equivalent of gift certificates, are represented as
6accounts on the issuer bank's database (FF). Thus, all three databases in claim 23
7element [3] are on the same site. Since this site contains the gift certificate
8accounts, it may be characterized as a gift certificate authority site. Further, since
9the databases identify the merchants and users, such identity information is among
10the information that would be used for authentication.

11 The Appellant contends that Gillin teaches away from the elements of claim 23
12(Appeal Br. 16:Last ¶). The Appellant contends that a programmatic infrastructure
13establishing direct connections to merchants is disclosed and claimed, whereas
14Gillin requires no relationship with merchants (Appeal Br. 17:First ¶).

15 We find no claim limitation regarding a direct connection to merchants in
16claim 23. In Gillin, a relationship is required with merchants who wish to accept
17payment using the cards (FF). Thus, we find this argument by the Appellant
18unpersuasive.

19 The Appellant next contends that Gillin offers nothing more than the sale of a
20temporary credit card (Appeal Br. 17:First full ¶).

21 We find nothing in claim 23 that precludes the sale of temporary cards. A gift
22certificate, which Gillin replaces, is by its nature temporary. To the extent the
23Appellant is arguing that Gillin does not sell gift certificates, Gillin expressly
24describes its instrument as the equivalent of a gift certificate (FF). Therefore, we
25find the appellant's arguments to be unpersuasive.

1 The Appellant next contends that Gillin teaches away from merchant databases
2because they would be unnecessary if transactions were handled by credit card
3suppliers (Appeal Br. 17:Second full ¶).

4 Gillin describes registering merchants who wish to accept payments using the
5cards with the acquiring bank (FF). Such registration records the merchant in the
6bank's records, which therefore form a database of merchants. Therefore, we find
7the appellant's arguments to be unpersuasive. To the extent the Appellant is
8arguing that a credit card supplier does not provide a Gift Certificate Authority
9Site, which claim 23 recites as the location of the database, claim 23 does not
10preclude a credit card supplier from providing a Gift Certificate Authority Site.
11Therefore, we find the appellant's arguments to be unpersuasive.

12 The Appellant next contends that Gillin does not describe merchant
13authentication (Appeal Br. 17:Second full ¶).

14 We initially find that claim 23 does not recite a step of authenticating, but the
15presence of an authentication protocol that allows authentication. Gillin expressly
16states that users are authorized (FF 7). Such an authorization performed by a
17merchant, by virtue of its use of the network used by the major credit cards (FF),
18inherently provides the protocol used by these credit card issuers and authenticates
19the merchant as one with the authority to perform such an authorization. Further,
20since Gillin's flow also allows use of payment forms such as those of CyberCash,
21which requires merchant registration, at least those merchants using CyberCash are
22authenticated. Therefore, we find the appellant's arguments to be unpersuasive.

23 The Appellant next contends that Gillin does not describe a software module
24on a merchant site expressly for the purpose of communicating directly with the
25Gift Certificate Authority Site and server application (Appeal Br. 18:First ¶).

1 We find that claim 23 contains no limitation of a software module on a
2 merchant site expressly for the purpose of communicating directly with the Gift
3 Certificate Authority Site and server application. To the extent the Appellant is
4 arguing that Gillin fails to show communication between the user, merchant, and
5 Gift Certificate Authority Site, Gillin in fact shows communication among those
6 entities (FF).

7 The Appellant next contends that Gillin does not suggest the claimed robust
8 range of utility and control (Appeal Br. 18:First ¶).

9 We find no recitation of a robust range of utility and control in claim 23.
10 Therefore, we find the appellant's arguments to be unpersuasive.

11 The Appellant further contends that the claimed gift certificate system doesn't
12 distribute credit card accounts and doesn't use an established credit card issuing
13 banking system (Reply Br. 2:Second full ¶).

14 Claim 23 recites no limitation precluding credit card accounts as the basis for
15 the gift certificates, nor use of an established credit card issuing banking system.
16 Therefore, we find the appellant's arguments to be unpersuasive.

17 The Appellant next contends that Gillin fails to show a gift certificate, just
18 credit cards, and fails to show a distributed network, or a plurality of merchants,
19 who all have sites connected to the distributed network. The Appellant argues that
20 Gillin's requirement that merchants be capable of seeking authorization restricts
21 some merchants from the network (Reply Br. 2:Last ¶).

22 Gillin expressly uses its transfer instrument as the equivalent of a gift
23 certificate (FF). Further, Gillin allows any merchant who is capable of processing
24 economic transactions involving one of the plurality national card accounts access.

1Such access is through a distributed network. To the extent the Appellant is
2arguing that claim 23 requires that all merchants who are connected to the network
3have access to the gift certificate, we find no such limitation in claim 23.
4Therefore, we find the appellant's arguments to be unpersuasive.

5The Appellant next contends that Gillin fails to show a Gift Certificate
6Authority Site (Reply Br. 3:First full ¶). The Appellant further contends, that if the
7Examiner equates Gillin's transfer instrument issuer with the Gift Certificate
8Authority Site, that the transfer instrument issuer has no relationship with
9merchants (Reply Br. 4:First ¶).

10Gillin shows show a Gift Certificate Authority Site (Gillin's transfer
11instrument account site) and a relationship with merchants (FF). Therefore, we
12find the appellant's arguments to be unpersuasive.

13The Appellant next repeats the above contentions that Gillin does not show
14merchants interacting directly with a Gift Certificate Authority Site (Reply Br.
154:Third ¶), and that Gillin has no merchant database (Reply Br. 5:First ¶). We find
16these contentions similarly unpersuasive in their repetition.

17The Appellant next contends that Gillin does not record gift certificate
18transaction data (Reply Br. 5:First and second full ¶).

19Gillin shows the use of the credit card infrastructure which records transaction
20data. Since Gillin's transfer instrument is implemented with such an account, the
21transaction data for the account would be gift certificate transaction data (FF).
22Therefore, we find the appellant's arguments to be unpersuasive.

23

24*Dependent Claims 24-28*

1 The Examiner found that Gillin teaches: (claim 24) placing restrictions on the
2use of the gift certificate; (claim 25) tracking use of the gift certificate by the user;
3(claim 26) search mechanism operatively associated with the gift certificate
4database that provides access to the user to those sales transactions associated with
5a particular user gift certificate; (claim 27) user anonymity that is effected by
6preventing merchant site access to any user related data, other than the gift
7certificate identification code; and (claim 28) within the gift certificate database,
8and in conjunction with merchant site processing of the gift certificate through the
9gift certificate database, splitting of the gift certificate across multiple purchases at
10a plurality of merchant sites (Answer 4:Last ¶-5:Fourth ¶).

11 The Appellant contends that the restrictions on the use of the gift certificate of
12claims 24 and 28, the ability to timely track, report and search transactions of
13claims 25 and 26, the level of anonymity provided the purchaser within Claim 27,
14all further defined in the specification, are not possible with a system and method
15that utilizes the existing credit/bank/charge card infrastructure, which is pointedly
16not configured to perform such functions. In fact, the current credit card system is
17configured to perform oppositely (Appeal Br. 18:Second ¶).

18 The Appellant further argues that in Claim 24, the only restrictions that may be
19placed on the use of the temporary credit cards of Gillin are those commensurate to
20an ordinary credit card purchase and that this is not the range of restrictions
21claimed and further described in Applicant's specification. The Appellant argues
22that the "transfer instrument" of Gillin could never restrict where purchases might
23be made as Applicant's system and method does, because it can be used wherever a
24credit card can be used (Appeal Br. 18:Last ¶ - Top of 19).

1 Gillin allows restrictions on the time frame and the amount of the instrument
2(FF). Claim 24 does not recite any particular restriction and claim 28 recites no
3restrictions. Ability to track, report and search transactions is an option in Gillin
4(FF). Gillin has the ability to make the purchaser anonymous to the recipient (FF
5). Therefore, we find the appellant's arguments to be unpersuasive.

6 *Independent Claim 29 and dependent claim 33*

7 The Examiner found that Gillin describes the elements of independent claim 29
8(Answer 5:Fifth ¶).

9 The Appellant, arguing claims 29 and 33 together, contends that Gillin assigns
10the purchaser one of their stockpile of credit card numbers, thereby again teaching
11away from creating a gift certificate with unique identifier, under the control of the
12Gift Certificate Authority Site of Applicant's system and method (Appeal Br.
1319:First full ¶).

14 Gillin's account number is a unique identifier under control of the issuer (FF).
15Therefore, we find the appellant's arguments to be unpersuasive.

16 *Dependent claims 30-32*

17 The Examiner found that Gillin teaches (claim 30) ahead of the step of gift
18certificate site validation, the user associates a fixed shipping address with the gift
19certificate; (claim 31) ahead of the step of gift certificate site validation, the user
20associates a restriction on certificate use the restriction selected from the group of
21restrictions consisting of restriction on certificate use by category of product or
22service, restriction on certificate use by age range of product or service, restriction
23on certificate use by dollar limitations on a per order or per item basis, restriction
24on certificate use by date of use range, and restriction on certificate use to use at

1selected merchant sites; and (claim 32) the restriction on certificate use is a
2restriction on certificate use by category of product or service (Appeal Br.
319:Second full ¶).

4 The Appellant, arguing claims 30-32 together, contends that Gillin teaches
5away, because restriction of the use of a credit/debit/charge card cannot be made.
6Without the claimed control over the gift certificate, the shipping address for
7purchases made with the gift certificate cannot be predetermined as required by
8Claim 30 and the restrictions described in Claims 31 and 32 cannot be. The
9Appellant points to several examples of restrictions in the Specification that are not
10found in Gillin (Reply Br. 6:Last 2 ¶'s to top of 7).

11 Gillin at least shows restrictions on the date of use range (FF), which is among
12the limitations, only one of which is needed, in claim 31. Gillin also describes
13getting claim 30's shipping address (FF). Therefore, we find the appellant's
14arguments to be unpersuasive.

15 *Independent Claim 34*

16 The Examiner found that that Gillin describes the elements of independent
17claim 34 (Answer 6:Third ¶).

18 The Appellant contends that Gillin does not teach an interaction between the
19merchants and a gift authority site; in fact it teaches away by teaching the
20necessary step of running all the transactions through "Acquiring Banks" (Appeal
21Br. 19:Third full ¶).

22 The Appellant argued this in claim 23 and we find it unpersuasive for the same
23reasons.

24 *Independent Claim 35 and dependent claims 36 and 37*

1 The Examiner found that that Gillin describes the elements of independent
2 claim 35 (Answer 6:Last ¶).

3 The Appellant contends that Gillin fails to present any teaching or suggestion
4 whatever as to contribution management or brokerage, and the Examiner has made
5 no reference at all to these claims as to alleged corresponding elements in Gillen.
6 The Appellant admits that, while a Gillen-style card itself could be donated to a
7 charity, the Appellant contends that its usefulness to the charity would be severely
8 limited to whether the card had a very large value or not; otherwise, the charity
9 would be constrained to use the card limits of dozens or hundreds of cards to effect
10 any significant purchases for its enterprise. In contrast, the claimed system allows
11 for direct deposit to a beneficiaries bank account, so that all contributions effected
12 through the claimed system are aggregate and fungible for any particular charity
13 (Appeal Br. 20:First ¶).

14 As the Examiner found, claim 35 is essentially the same as claim 23 with the
15 word “beneficiary” replacing “merchant” and the word contribution” replacing the
16 phrase “gift certificate” (Answer 6:Last ¶). The Examiner argues that this
17 distinction is non-functional, which we find as well. Thus, the Appellant is merely
18 claiming providing the gift certificate of claim 23 to a beneficiary. Since both
19 claims are system claims, the structure is identical and therefore the finding that
20 Gillin anticipates claim 23 necessarily means that it also anticipates claim 35.

21

22 The Appellant has not sustained its burden of showing that the Examiner erred
23 in rejecting claims 23-37 under 35 U.S.C. § 102(e) as anticipated by Gillin.
24 Therefore, we find the appellant's arguments to be unpersuasive.

2 The Appellant contends that the Examiner has made no attempt to address
3 arguments presented by Applicant in his original brief regarding the distinction
4 between the appealed claims and a system based upon existing infrastructures for
5 temporary credit cards, even though the previously cited articles, Webcertificate 1
6 and 2 were based upon just such a system and such arguments were presented by
7 Applicant in the original brief (Appeal Br. 20:Second ¶).

8 As we noted above, the Examiner withdrew the rejections under 35 U.S.C.
9§ 103, so they are not before us. Thus, any of Appellant's contentions regarding
10such withdrawn rejections are therefore moot. Thus, we find no reversible error in
11the Examiner's failure to address Appellant's contentions regarding the withdrawn
12rejections.

CONCLUSIONS OF LAW

14 The Appellant has not sustained its burden of showing that the Examiner erred
15 in rejecting claims 23-37 under 35 U.S.C. § 103(a) as unpatentable over the prior
16 art.

17 On this record, the Appellant is not entitled to a patent containing claims
1823-37

84Appeal 2007-1813
85Application 09/324,601
86

1 DECISION

2 To summarize, our decision is as follows:

- 3 • The rejection of claims 23-37 under 35 U.S.C. § 102(e) as anticipated by
4 Gillin is sustained.

5 No time period for taking any subsequent action in connection with this appeal
6 may be extended under 37 CFR § 1.136(a)(1)(iv).

7

8 AFFIRMED

9

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11vsh

12

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15

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